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Ilan Twig

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EXAMINER

CHEN, TE Y

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/734,159	Applicant(s) TWIG ET AL.	
	Examiner SUSAN Y. CHEN	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-18, 25-27, 30, 31 and 39-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-18, 25-27, 30-31, 39-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/04/2009 has been entered.

This office action is in response to the amendment filed on March 4, 2009.

Claims 3-18, 25-27, 30-31 and 39-51 are pending for examination; claims 3, 5, 30, 41, 46 and 48 have been amended; claims 50-51 have been newly added.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 51 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 51, this system claim seemed to have an abstract utility in the preamble for providing information related to commercial enterprises, however, in the body of the claim which lacks of any physical device such as a computer or machine to

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really execute the claimed means plus function steps, as such, it merely directs to non-statutory subject matter. In re Bilsky.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-18, 25-27, 30-31 and 39-51, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,948,040 issued to DeLorme et al. (hereinafter referred as DeLorme).

Claim 3:

DeLorme discloses a system for presenting results of a search query pertaining to commercial enterprises, the system comprising a server executing a software application [e.g., Abstract] being designed for:

storing geographical map data and data pertaining to commercial enterprises, said geographical map data representative of at least one map image of a geographic area [e.g., the TRIP database at col. 7, lines 66 – col. 8, lines 48, col. 10, lines 10 - 18];

receiving from a user client a search request pertaining to the commercial enterprises [e.g., Fig. 4 and associated texts]; and

providing said user client with a search result responsive to said search request, the search result comprising a subset of said data pertaining to the commercial enterprises, said search result sufficient to enable said user client to instantiate an image including one or more representations based on said subset superimposed over a map image of a geographic area represented by said geographical map data and render navigable areas within said geographical area without requiring new map data to be provided to the user client, wherein a level of visibility of each enterprise representation in said image is determined according to at least one selection criterion [e.g., Fig(s). 1 B-C, 8-9 and associated texts, wherein the map display technology allows zoom in/out to different scale maps with variable resolution or levels of details to pan or shift seamlessly across to other map locations via the computer aided routing & positioning utilities provided by auxiliary devices at col. 24, lines 29 – col. 26, lines 28].

Claim 4:

DeLorme further discloses that a subset of said map data is provided by said server along with said data pertaining to a plurality of commercial enterprises [e.g., the online remote database server at col. 10, lines 10 - 58].

Claim 5:

In addition to the limitations recited in claim 3, DeLorme further discloses that said map data is stored by said user client and said data pertaining to a plurality of commercial enterprises includes information for superimposing each of said plurality of commercial enterprises over said map data [e.g., col. 66, lines 63 – col. 67, lines 28].

Claim 6:

In addition to the limitations recited in claim 3, DeLorme further discloses that said subset include businesses related content [e.g., col. 11, lines 1 - 39].

Claim 7:

In addition to the limitations recited in claim 3, DeLorme further discloses that said at least one selection criteria forms a part of a user-specific profile [e.g., col. 61, lines 10-26].

Claim 8:

In addition to the limitations recited in claim 7, DeLorme further discloses that the user-specific profile is generated by said server according to information provided from said user client [e.g., the unit 809, Fig. 8A and associated texts].

Claim 9:

In addition to the limitations recited in claim 3, DeLorme further discloses that said image further displays commercial enterprise-related information for each of said representations [e.g., col. 1, lines 28 – 46].

Claim 10:

In addition to the limitations recited in claim 9, DeLorme further discloses that said commercial enterprises-related information is provided to said user client by said server as various layer of information [e.g., Fig. 2 and associated texts, , col. 19, lines 59 – col. 20, lines 6].

Claim 11:

In addition to the limitations recited in claim 3, DeLorme further discloses that said server is further capable of providing said user with information relating to a group of commercial enterprises [e.g., col. 27, lines 64 – col. 29, lines 9].

Claim 12:

In addition to the limitations recited in claim 3, DeLorme further disclose that said server is also capable of managing an affiliation of said user to consumer clubs associated with at least one commercial enterprise of said plurality of commercial enterprises [e.g., col. 34, lines 26 - 56].

Claim 13:

In addition to the limitations recited in claim 3, DeLorme further discloses that of periodically receiving from at least one of said commercial enterprises information relating thereto [e.g., Fig. 9 and associated texts].

Claim 14:

In addition to the limitations recited in claim 3, DeLorme further discloses that said selection criterion includes relevancy of the one or more representations [e.g., col. 69, lines 35 – col. 70, lines 63].

Claim 15:

In addition to the limitations recited in claim 3, DeLorme further discloses that said level of visibility is a function of at least one of a graphical display size, color or animation of each of said commercial enterprises [e.g., col. 22, lines 38 – 61, Fig. 1C and associated texts].

Claim 16:

In addition to the limitations recited in claim 3, DeLorme further discloses that said server is capable of enabling bidirectional communication between said user client and at least one of said commercial enterprises [e.g., the use of two-way communications in Fig. 9 and associated texts].

Claim 17:

In addition to the limitations recited in claim 3, DeLorme further discloses that at least one selection criteria is a subscription fee paid by at least one of said commercial enterprises [e.g., col. 64, lines 11 – 44].

Claim 18:

In addition to the limitations recited in claim 10, DeLorme further discloses that said commercial enterprise-related information is updated dynamically by said server [e.g., col. 10, lines 10 - 18].

Claim 25:

In addition to the limitations recited in claim 3, DeLorme further discloses that said subset includes advertised content [e.g., col. 36, lines 52 – col. 37, lines 2].

Claim 26:

In addition to the limitations recited in claim 3, this claim recites similar subject matters as claim 15, hence are rejected along the same rational.

Claim 27:

In addition to the limitations recited in claim 3, DeLorme further discloses that said level of visibility is a function of an animation of each of said data pertaining to commercial enterprises [e.g., col. 47, lines 8 - 43].

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Claim 39:

In addition to the limitations recited in claim 3, DeLorme further discloses that at least one selection criterion is geographical location [e.g., col. 24, lines 50 – col. 25, lines 3].

Claim 40:

In addition to the limitations recited in claim 3, DeLorme further discloses that each of said representations is positioned in said image according to its respective location on said map image [e.g., Fig.(s) 1A – 1B3 and associated texts].

Claims 30 – 31 and 48 -49:

These claims recite similar features as claims 3 – 17, 25-27 and 39-40, in form of computerized geographic-mapping or map data from server to a computer device method with slightly different wording, hence, are rejected for the same reason.

Claims 41 – 47:

These claims recite similar features as claims 3 – 17, 25-27 and 39-40, in form of a computer system program product, with slightly different wording, hence, are rejected for the same reason.

Claims 50 – 51:

These claims recite similar features as claims 3 – 17, 25-27 and 39-40, in form of computer storage medium or an abstract system, thereby, are rejected for the same reason.

Response to Arguments

Applicant's arguments based on newly amended limitations filed on March 04, 2009 have been fully considered but they are not persuasive.

The examiner disagrees with applicant arguments that Delorme failed to disclose the claimed “search result sufficient to render navigable areas within said geographical area without requiring new map data to be provided to the user client.”

In reply to the above argument the examiner first points out that the amended claim limitation does not match the paragraph 24 citation of instant specification as specified by Applicant. Wherein, the specification clearly stated the following:

“downloading sufficient map data to the client machine to allow an operator of the client machine to navigate within said geographical region without requiring new map data to be downloaded from the map server”

As set forth above, the claimed limitation clearly fails to recite the links or concept of the downloading process with the claimed limitations.

Furthermore, in contrary to applicant's arguments, Delorme clearly disclosed the claimed features. For example, in refer to Fig(s). 1 B-C, 8-9 and associated texts of Delorme's invention, he clearly cited that the map display technology of his invention allows zoom in/out to different scale maps with variable resolution or levels of details to

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pan or shift seamlessly across to other map locations via the computer aided routing & positioning utilities provided by auxiliary devices [specifically see col. 24, lines 29 – col. 26, lines 28], as such, the map display zoom schema are default to allow an operator of the client machine to navigate within the displayed map geographical region without requiring new map data to be downloaded from the map server.

Based on the discussion above, it is believed that the rejections on record should be sustained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Lecton et al. (U.S. Patent No. 7,089,507) which disclosed a system with method for displaying views using a single stroke control.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SUSAN Y. CHEN whose telephone number is (571)272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susan Y Chen/
Partial Sig. Examiner
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April 27, 2009